

The opinion in support of the decision being entered today was
not written for publication and is **not** precedent of the Board.

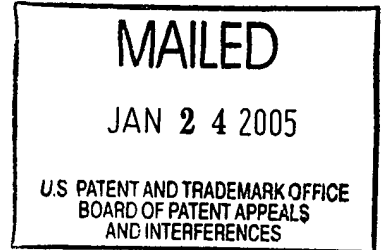
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MASAhide ONUKI, MAKOTO YOSHIDE,
and TETSUO YAMAGUCHI

Appeal No. 2005-2638
Application No. 09/194,112

HEARD: November 15, 2005



Before OWENS, KRATZ, and FRANKLIN, **Administrative Patent Judges.**
FRANKLIN, **Administrative Patent Judge.**

DECISION ON APPEAL

This is a decision on appeal under 35 USC § 134 from the
examiner's final rejection of claims 1-38 and 44-46. Claims 39-
41 and claims 48-50 have been withdrawn from a prior election of
species requirement. Brief, page 3.

The examiner relies upon the following references as
evidence of unpatentability:

Anderson	5,261,663	Nov. 16, 1993
Kobayashi	5,601,501	Feb. 11, 1997
Kobayashi	5,611,742	Mar. 18, 1997
Sieleman et al. (Sieleman)	5,792,005	Aug. 11, 1998
Peker et al.	5,896,642	Apr. 27, 1999

(Peker)

We observe that on page 4 of the answer, the examiner lists the following references:

Campau	4,398,965	Aug. 16, 1983
Tsuchiya et al.	5,346,217	Sep. 13, 1994
(Tsuchiya)		
Yamashita et al.	5,378,295	Jan. 03, 1995
(Yamashita)		
Lu	5,499,814	Mar. 19, 1996
Yoshida et al.	5,569,337	Oct. 29, 1996
(Yoshida)		
Aizawa	5,643,103	Jul. 01, 1997
Japan, Derwent, Basic-Abstract 49-40211,		Apr. 15, 1974
Japan, Derwent, Basic-Abstract 1-254179,		Oct. 11, 1998

However, the above-listed references were not applied in any art rejection and was, for the first time, listed in the answer, and discussed for the first time, on pages 15-16 of the answer. As such, we do not consider these references in this decision.

Claims 21, 23-25, 30, and 38 stand rejected under 35 U.S.C. § 103 as being obvious over Peker.

Claims 1-20, 22, 26-29, 31-32, and 33-37 stand rejected under 35 U.S.C. § 103 as being obvious over Peker in view of Kobayashi.

Claims 42 and 43 stand rejected under 35 U.S.C. § 103 as being obvious over Peker and Kobayashi and further in view of Anderson.

Claim 44 stands rejected under 35 U.S.C. § 103 as being obvious over Peker in view of Anderson.

Claims 1, 5, and 45-46¹ stand rejected under 35 U.S.C. § 103 as being obvious over Peker in view of Kobayashi and Sieleman.

OPINION

I. The 35 U.S.C. § 103 rejection of claims 21, 23-25, 30, and 38 as being obvious over Peker

We refer to pages 5-6 of the answer regarding the examiner's position for this rejection. We refer to pages 7-12 of the brief regarding appellants' response to this rejection. Appellants also provide comments in the reply brief.

Appellants argue that the Young's modulus value recited in claim 21 is not disclosed in Peker. Appellants also argue that the tensile strength value disclosed in claim 21 is not disclosed in Peker. (Brief, page 8).

On page 5 of the answer, the examiner recognizes that Peker does not disclose (1) the claimed Young's modulus value and the

¹ On page 8 of the answer, the examiner erroneously includes cancelled claim 47 in this rejection. See page 2 of the amendment after final, filed on October 30 2003, and the advisory action dated November 19, 2003, item no. 27, of which approves entry of that amendment.

tensile strength (Peker teaches a tensile strength of 194 kgf/mm²) and (2) the relationship between Young's modulus and tensile strength, as defined by claim 30.

It is the examiner's position that it would have been obvious "to modify the face of Peker to have a Young's modulus and tensile strength as defined by appellants' claims in order to have a face which has a sufficient flex for a specific golfer." Answer, page 6.

In response, at the top of page 10 of the brief, appellants argue that Peker provides "no motivation or suggestion for modifying the composition of metals anywhere" to arrive at their claimed invention. We agree.

We note that obviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggesting, or motivation to do so found either in the reference or in the knowledge generally available to one of ordinary skill in the art. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Here, the examiner does not point to any teaching in Peker that suggests modifying the face of Peker to arrive at the claimed invention. The examiner states that the materials of Peker would have inherent properties, such as Young's modulus

and tensile strength, dependent on the composition and the method of manufacturing. Answer, page 15.²

The examiner also states that Peker suggests the claimed invention because "one skilled in the art would select an obvious and suitable manufacturing process to produce inherent properties which are obvious and suitable selections for a golf club head which would [have] included the claimed values of the properties." Answer, page 16. Yet, the examiner does not explain the motivation for selecting a particular material and process³, resulting in a product having properties inherent to the particular material and process. Stated another way, the

² We note that the examiner states that "Peker discloses the alloys which meet the percentages as defined in the claims (claims 14-19)". Answer, page 15. Appellants dispute this statement made by the examiner. Brief, page 11. Appellants state that Appendix D shows that the compositions disclosed in Peker in fact are not the same as the compositions disclosed in the instant invention, and refer to "Appendix D". Brief, page 11. Apparently, however, while Appellants referred to an "Appendix D" on page 11 of the brief, no document was labeled as "Appendix D"; rather, the document was simply entitled "Table 2". That is, while appellants submitted Table 2, it was not labeled as "Appendix D". The examiner dismissed this table (which was presented for the first time in the brief) because Table 2 did not include the label "Appendix D." See page 17 of the answer. Appellants, in their reply brief, again submitted Table 2, having the label "Appendix D", to clarify the record. This reply brief was noted by the examiner. Table 2 of Appendix D reflects the disclosure in Peker, at column 4, lines 23-43. Hence, this data already existed in the Peker reference. Table 2 also shows alloy compositions found in appellants' specification. A comparison of this set of data found in Table 2 of Appendix D supports appellants' position.

³ Appellants correctly point out that Peker does not set forth the method of manufacturing. Brief, pages 10-11. The examiner agrees with the appellants' findings in this regard. Answer, page 16.

examiner points to no teaching in Peker that suggests modifying Peker to arrive at appellants' claimed invention.

These above described circumstances lead us to conclude that the examiner, in making his Section 103 rejections, has fallen victim to the insidious effect of hindsight syndrome wherein that which only the inventor has taught is used against its teacher. W.L. Gore & Assocs. V. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). We point out that "[o]bviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination." In re Geiger, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987).

In view of the above, we therefore reverse the 35 U.S.C. § 103 rejection of claims 21, 23-25, 30, and 38 as being obvious under 35 U.S.C. § 103 over Peker.

II. The 35 U.S.C. § 103 rejection of claims 1-20, 22, 26-29, and 31-32, and 33-37 as being obvious over Peker in view of Kobayashi

The same issue exists in this rejection as discussed above with respect to the previous rejection. That is, the issue is whether Peker suggests a golf club head having a hitting face

formed at least partially by a metallic material having the properties recited in claim 1.

Again, the examiner's position is that the hitting face material of Peker does have a Young's modulus and a hardness value, and that one skilled would have selected a composition having a suitable hardness and Young's modulus value as recited in the claim. For the same reasons, as discussed supra, we disagree with the examiner's position.

In view of the above, we therefore reverse the 35 U.S.C. § 103 rejection of claims 1-20, 22, 26-29, 31, 32, and 33-37.

III. The rejection of claims 42 and 43 under 35 U.S.C. § 103 as being obvious over Peker and Kobayashi and further in view of Anderson

The examiner's position for this rejection is set forth on page 7 of the answer. Appellants' response to this rejection is set forth on pages 18-22 of the brief. Appellants also provide comments in the reply brief.

Appellants' arguments are the same arguments with regard to the arguments appellants presented concerning claim 1 and claim 5, because claim 42 depends upon claim 1, and claim 43 depends upon claim 5. Hence, we have already addressed the issues raised in connection with claims 1 and 5. Therefore, for the

same reasons that we reversed the rejection of claims 1 and 5, we also reverse the rejection of claims 42 and 43.

IV. The 35 U.S.C. § 103 rejection of claim 44 as being obvious over Peker in view of Anderson

Appellants grouped claim 44 with claim 21. (Brief, page 6). Hence, the same arguments provided by appellants regarding the patentability of claim 21 also apply to claim 44. Also, Anderson does not cure the aforementioned deficiencies of Peker.

Hence, for the reasons that we reversed the rejection of claim 21, we also reverse the rejection of claim 44.

V. The 35 U.S.C. § 103 rejection of claims 1, 5, and 45-46 as being obvious over Peker in view of Kobayashi and Sieleman

The examiner's position for this rejection is set forth on pages 8-10 of the answer. We first note that, on page 22 of the brief, appellants recite that claims 1, 5, and 45-46 are rejected, however, on page 8 of the answer, the examiner indicates that claims 1, 5, and 45-46 stand rejected.

Appellants' position regarding this rejection is set forth on pages 22-26 of the brief. Appellants also set forth comments in the reply brief. Upon our review of appellants' response to this rejection, appellants set forth the very same arguments as presented regarding claims 1 and 5, as discussed, supra. That is, appellants' basic position is that claims 1 and 5 recite

particular values for the Young's modulus and tensile strength and Vickers hardness and that neither Peker or Kobayashi or Sieleman suggests these values. We agree, for the same reasons discussed, supra. Furthermore, Kobayashi and Sieleman do not cure the deficiencies of Peker.

In view of the above, we therefore reverse the 35 U.S.C. § 103 rejection of claims 1, 5, and 45-46.

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VI. Conclusion

Each of the rejections is reversed.

REVERSED

Terry J. Owens
TERRY J. OWENS
Administrative Patent Judge


PETER F. KRATZ
Administrative Patent Judge

) BOARD OF PATENT
) APPEALS AND
) INTERFERENCES

Beverly A. Franklin
BEVERLY A. FRANKLIN
Administrative Patent Judge

BAP/sld

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